

REMARKS

This Amendment is submitted in response to the Office Action dated April 30, 2001. In the Office Action, the Patent Office objected to the drawings under 37 CFR §1.83(a) as not showing every feature of the invention specified in the claims. In addition, Claims 1, 9, 15 and 17 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification. Further, Claims 9 and 14 were rejected under 35 U.S.C. §102(b) as being anticipated by *Fisher*; and Claims 15 and 16 were rejected under 35 U.S.C. §102(b) as being anticipated by *Martin et al.* Still further, the Patent Office rejected Claims 1-4, 6-8, 17 and 19 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin*; rejected Claims 5 and 13 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin* as applied to Claims 1 and 17 and further in view of Applicant's disclosure; and rejected Claim 11 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of Applicant's disclosure.

By the present Amendment, Applicant amended Claims 1, 9 and 15-17. Applicant submits that the amendments and the remarks that follow overcome the objection and rejections made by the Patent Office and place the application in condition for allowance.

In the Office Action, the Patent Office objected to the drawings under 37 CFR §1.83(a). The Examiner contends that the drawings must show every feature of the invention specified in

the claims; namely, the surface (Claims 1, 15 and 17) must be shown or the feature canceled from the claims. Contrary to the assertion made by the Examiner, Applicant need only furnish a drawing where necessary for the understanding of the subject matter sought to be patented. See 35 U.S.C. §113 and 37 CFR §1.81.

The claimed invention defines, in part, a marking device, a method of using the marking device and an accessory kit for the marking device. As disclosed in the thirteenth paragraph of the DETAILED DESCRIPTION OF THE PRESENTLY PREFERRED EMBODIMENTS, "[t]he connecting lead 72 may connect to any surface, such as, for example, a wall, an ATM machine, a desk or any other like surface." Accordingly, the specification clearly defines the type of surface in which Applicant's invention may be attached. Moreover, the marking device may be implemented to attach to any surface and should not be constructed to being limited to the surfaces described in the thirteenth paragraph of the specification.

Moreover, Applicant submits that a drawing of a surface, such as, for example, a wall, an ATM machine, a desk or any other like surface, is not necessary for the understanding of the present invention. Moreover, one skilled in the art would fully comprehend how Applicant's device could be attached to any surface, and a drawing of the surface is not necessary to understand connection of the surface to the device. Nonetheless, Applicant cancelled the reference to "surface" in Claims 1, 15

and 17. Accordingly, Applicant submits that the objection to the drawing has been overcome. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claims 1, 9, 15 and 17 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that Applicant, at the time the application was filed, had possession of the claimed invention. More specifically, the Examiner stated,

the recitation of the lead being "removably" attached to a surface is considered to be new matter the recitation of the lead having an end "removably" connected to the end cap is considered to be new matter the recitation of the clamp "removably" securing the article to the barrel is considered to be new matter. It is noted that even though the clamp has been disclosed as being screwed to the article, the specification does not disclose the screws as being removable, i.e., some anchor type screws are not removable.

(Paragraph 2 of the April 30, 2001 Office Action.)

Applicant draws attention to the last sentence of paragraph 5 of the DETAILED DESCRIPTION OF THE PRESENTLY PREFERRED EMBODIMENTS of the original specification wherein Applicant discloses, "the sheath 10 may be removable from the marking device for replacement purposes. . . ." Further, in paragraphs 8 and 9 of the DETAILED DESCRIPTION OF THE PRESENTLY PREFERRED EMBODIMENTS of the original specification Applicant discloses, "[t]he sheath 60 . . . may wrap around the barrel 52 of the marking device 50 to be fixed in place by the bands 64. . . . A

tool 68 may be utilized to fasten the screws 66 onto the bands 64 thereby fixing the sheath 60 to the barrel 52." Still further, in paragraph 16 of the DETAILED DESCRIPTION OF THE PRESENTLY PREFERRED EMBODIMENTS of the original specification, Applicant discloses "[t]he sheath 100 may be unwrapped from the marking device 50 for purposes of replacement when worn or when the sheath 100 has otherwise lost its effectiveness. Alternatively, the adhesive 104 may permanently adhere the sheath 100 to the barrel 52."

The original specification, therefore, clearly discloses that the sheath may be replaced, or , alternatively, permanently adhered to the barrel. Thus, screws, for example, that fix the sheath to the barrel may be removed to replace the sheath. Further, nowhere in the specification does Applicant disclose screws that are not removable. Applicant does not teach that the sheath must be permanently adhered to the marking device. Rather, Applicant discloses a sheath that may be removed, replaced, or alternatively, may be permanently adhered to the marking device.

As to the rejection of Claim 15 under 35 U.S.C. §112, first paragraph, for the lead having an end "removably" connected to the end cap being considered new matter, Applicant submits that the lead is removably connected to the end cap and is removably attached. A surface is described in the original specification as set forth above in the objections to the drawings. In paragraph 13 of the DETAILED DESCRIPTION OF THE PRESENTLY

PREFERRED EMBODIMENTS of the original specification, Applicant discloses, "[t]he connecting lead 72 may extend from the end cap 70 and may be integrally formed with the end cap 70. However, the connecting lead 72 may extend from a hole contained on an end of the pen cap 70." Further, Figures 2 and 3 both show the connecting lead 72 having a commonly known end for attachment and detachment. Thus, the lead may be detached or may be removably connected to a surface and/or an end cap.

Applicant submits that these features were clearly shown in the Figures and described in the specification as originally filed with the application. Therefore, Applicant submits that the rejection of Claims 1, 9, 15 and 17 under 35 U.S.C. §112, first paragraph, has been overcome and should be withdrawn. Notice to that effect is requested.

As to the rejection of Claims 9 and 14-16 under 35 U.S.C. §102(b), Applicant respectfully submits that the claims, as amended, are not anticipated by *Fisher* or *Martin et al.* Further, Applicant submits that the amendments to Claims 9 and 15-17 and the reasons that follow overcome the rejections of the Patent Office.

More specifically, Claim 9 was amended to define a marking device accessory kit comprising a marking device having a barrel, a flat article, a clamp, a cap and a lead. The barrel is defined between a first end and a second end wherein the first end has a tip capable of producing a mark. The flat article wraps around the barrel of the marking device. The clamp removably secures

the flat article around the barrel of the marking device. Further, the cap, having a lead extending from the cap, is removably attached to the barrel at the second end.

The Patent Office submits that *Fisher*

"discloses a 'device accessory kit' comprised of a marking device, a flat article which wraps around the marking device and a 'clamp' (the stitching, in as much as the applicant has defined the term 'clamp', as stitching is used to 'clamp' together articles, stitching can be considered a clamp) which 'removably secures' the article to the marking device, i.e., as stitching can be removed, the stitching removably secures the article to the marking device."

Paragraph 4 of the April 30, 2001 Office Action. *Fisher* does not teach a cap having a lead attached to the barrel of the marking device. Applicant's invention, however, claims a marking device accessory kit comprising a cap having a lead attached to the barrel of the marking device.

Amended Claim 15 defines a marking device accessory kit. The accessory kit has a marking device having a body, an end cap and a connecting lead. The body is defined between a first end and a second end wherein the first end has a tip capable of producing a mark. The end cap is removably attached on the second end of the marking device and is interchangeable between a plurality of marking devices. The connecting lead has a first end and a second end. The first end of the connecting lead extends from the end cap and is removably connected to the end cap.

In the Office Action, the Patent Office alleges that *Martin et al.* discloses "a chain 14 connected to the end cap wherein the chain has a first end 'removably' connected to the end cap and another end 'removably' connected to a surface 18 remote from the end cap." *Martin et al.* teach the attachment of the chain as follows:

The chain is attached to the upper curved extremity of the stem. . . in view of which the pencil hangs free and away from the stem. The lower end of the stem is inserted and held in the tube 12, and it takes all the tension and strain without the aid of any reinforcements. Over the curved extremity 17 of the stem is slipped and held a small sleeve 18. The inner end of the sleeve is pressed slightly together as indicated at 19 to grip the part 17, and its outer end is also pressed inward to form an internal annular flange 20 which is spaced slightly from the extremity of the part 17 to accommodate a small disk or washer 21, the same being loosely mounted in the sleeve between the flange 20 and the extremity of the part 17 so as to be free to rotate. To the center of the disk 21 is attached the chain 14. The pencil holder 15 carried by the chain is designed to accommodate different sized pencils or pen holders. As the disk 21 is rotatable, the chain and the parts carried thereby operate freely in any direction. The disk also conceals the extremity of the stem. The holder 15 has an eye 22 for attachment of the chain.

See *Martin et al.*, U.S. Patent No. 1,134,691, 2nd Column, lines 63-90.

Thus, the chain taught by *Martin et al.* is attached to a stem on one end and a holder on the other end. Nowhere does *Martin et al.* even intimate that the chain is removably attached to the stem. The chain in *Martin et al.* is connected only to the holder of a pencil on one end and to a stem that suspends the

chain on the other end. The chain disclosed by *Martin et al.* may only be connected to the pencil on one end and the stem on the other to achieve the purpose of, "pencil holders designed to support a pencil or other writing device *suspended* above the top of a table, desk or other surface." (emphasis added) See *Martin et al.*, column 1, lines 9-12. *Martin et al.* suspend pencils over a surface. Applicant's invention, however, discloses a connecting lead that is removably attached directly to any of a number of surfaces. Applicant's invention is not limited to being attached to a specific stem and base.

Under 35 U.S.C. §102, anticipation requires that a single reference discloses each and every element of Applicant's claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPO 2d. 1241, 1245 (Fed. Cir. 1986).

Moreover, anticipation is not shown even if the differences between the claims and the reference are "insubstantial" and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d. 707, 716, 223 USPO 1264, 1270 (Fed. Cir. 1984).

Since neither *Fisher* nor *Martin et al.* teach the elements defined in amended Claim 9 and/or amended Claim 15, the rejection under 35 U.S.C. §102(b) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 1-4, 6-8, 17 and 19 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin et al.*; the rejection of Claims 5 and 18 under 35

U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin et al.* and further in view of Applicant's disclosure; and the rejection of Claim 11 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of Applicant's disclosure, Applicant respectfully submits that the claims, as amended, distinctly define the present invention from any of the art of record, taken singly or in combination, for the reasons that follow.

More specifically, amended Claims 1 and 17 define a marking device and a method for using a marking device wherein an end cap has a connecting lead. Further, amended Claim 17 teaches a connecting lead having a first end and a second end wherein the first end is removably connected to the end cap.

Neither *Fischer* nor *Martin et al.* teach a connecting lead having a first end and a second end wherein the first end is removably connected to an end cap, and the second end is removably connected to any of a number of surfaces.

The Patent Office submits that *Fischer* "discloses a marking device covered with a sheath. Although *Fischer* does not disclose the use of an end cap, attention is directed to the *Martin et al.* reference which, as discussed *supra*, discloses an end cap for a marking instrument as claimed in order to enable the marking instrument to be secured to a particular location."

The marking instrument in *Martin et al.* is secured only to a base having a tube such that the marking device suspends over a surface. The tube supports a flexible stem to which a clasp

carrying a pencil is attached. The pencil in *Martin et al.* may only be secured to this base not to any surface, whereas, Applicant's invention allows for an end cap having a connecting lead to be removably attached to a surface, such as, for example, a wall, an ATM machine, a desk or any other like surface. Further, *Martin et al.* teach a base that suspends a writing device over a surface.

This invention relates to pencil holders designed to support a pencil or other writing device suspended above the top of a table, desk or other surface, and more particularly a holder having a flexible stem from which is suspended a clasp which carries the pencil, and which stem is free to yield in any direction so that the pencil may be lowered into position for use, and when released is swung back to elevated position by the stem assuming its normal, erect position.

It is the object of the invention to provide in a device of the kind stated a novel support and attachment for the pencil clasp, which enables the pencil to be freely operated in any position.

Martin et al., Column 1, lines 9-25.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious

to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

Moreover, it is insufficient that the art disclosed components of Applicant's assembly, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by the inventor. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the resultant combination still lacks the critical features and structural relationships positively recited in the amended claims as set forth above.

With the analysis of the deficiencies of the *Fischer* and *Martin et al.* patents in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Accordingly, the rejection of Claims 1 and 17 under 35 U.S.C. §103(a) has been overcome and should be withdrawn.

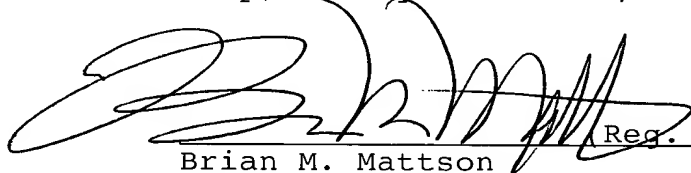
Claims 2-8 depend from Claim 1; Claims 11-14 depend from Claim 9; Claim 16 depends from Claim 15; and Claims 18-20 depend from Claim 17. These claims are further believed allowable over

the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional structural elements and steps of Applicant's marking device with accessory kit and method for using the same, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. Further, Applicant submits that neither further search nor consideration would be necessitated by entry of this Amendment. Therefore, entry of this Amendment is proper and should be effected.

If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



(Reg. No. 35,018)

Brian M. Mattson
Patents+TMS
A Professional Corporation
1914 North Milwaukee Avenue
Chicago, IL 60647
773/772-6009
Attorney for Applicant



VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 1, as amended, follows:

1. (Twice Amended) A marking device comprising:
a barrel having a body defined between a first end and a second end wherein the first end has a tip capable of producing a mark;
a sheath that fits over the body of the barrel between the first end and the second end; and
an end cap removably attached [for fitting] on [an] the second end of the barrel wherein the end cap has a connecting lead extending from the end cap [removably attached to a surface].

Claim 9, as amended, follows:

9. (Twice Amended) A marking device accessory kit, the accessory kit comprising:
a marking device having a barrel defined between a first end and a second end wherein the first end has a tip capable of producing a mark;
a flat article wherein the article wraps around the barrel of the marking device between the first end and the second end;
[and]
a clamp wherein the clamp removably secures the flat article around the barrel of the marking device; and
a cap having a lead extending from the cap wherein the cap is removably attached to the barrel at the second end.

Claim 15, as amended follows:

15. (Twice Amended) A marking device accessory kit, the accessory kit comprising:

a marking device having a body defined between a first end and a second end wherein the first end has a tip capable of producing a mark [an end];

an end cap removably attached [fitting] on the second end of the marking device wherein the end cap is interchangeable between a plurality of marking devices; and

a connecting lead having a first end and a second end wherein the first end of the connecting lead extends from the end cap and is removably connected to the end cap [and the second end is removably connected to a surface remote from the end cap].

Claim 16, as amended follows:

16. (Once Amended) The accessory kit of Claim [14] 15 wherein the connecting lead is a chain.

Claim 17, as amended, follows:

17. (Twice Amended) A method of using a marking device, the method comprising the steps of:

providing a barrel having a body defined between a first end and a second end wherein the first end has a tip capable of producing a mark [having an end];

providing a sheath that fits over the barrel between the first end and the second end;

providing an end cap for fitting over the second [an] end of the barrel wherein the end cap has a connecting lead that extends from the end cap [removably connected to a surface];

fitting the sheath over the barrel between the first end and the second end; and

fitting the end cap over the second end of the barrel.